UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,037	10/15/2003	Erich Kast	BE-119	4999

7590 10/13/2004

Friedrich Kueffner
Suite 910
317 Madison Avenue
New York, NY 10017

EXAMINER	
COMSTOCK, DAVID C	

ART UNIT	PAPER NUMBER
3732	

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/686,037	KAST ET AL.	
	Examiner	Art Unit	
	David Comstock	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claims 6 and 7 are objected to because of the following minor informalities:

Claim 6, line 3, after "having", "with" should be deleted.

Claim 7, line 2, after "configured", --to-- should be inserted.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Bernard et al. (FR 2 795 945).

Bernard discloses an implant 1 having a height that increases from a ventral side 5 to a dorsal side 4 to a maximum height and then decreases again (see Figs. 1-3). The maximum height is located in a last third of a length of the implant (see esp. Fig. 3). The implant has a height that increases from its outer extents toward a center axis in a direction perpendicular to a center axis passing through the spine from front to back. The implant is symmetrically shaped with

respect to a plane that perpendicularly intersects a longitudinal axis of the spine. The implant includes projections 11. The anterior end face 5 has a generally convex shape, i.e. outwardly curving, at least when taken between the planar side walls, e.g. 2 (see Fig. 1). The implant has a hollow, cage-like configuration with wall openings 20. When viewed from above it has a frame-like configuration with an opening therein to the upper side and the lower side (see Fig. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bernard et al. (FR 2 795 945) in view of Bagga et al. (2003/0125739).

Bernard et al. disclose the claimed invention except for the implant being configured to be placeable in a half-space with another like implant. Bagga et al. disclose similar implants, e.g. 10,240, and also teaches that the implants can advantageously be configured to be used alongside a mirror-image implant in a vertebral space in order to allow bone graft material to be placed between the two implants and to provide maximum contact and between natural bone and the implants (see, e.g. Figs. 1 and 20 and par. 0128). It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide the

implant of Bernard et al. with a configuration for use in a half-space with a like implant, in view of Bagga et al., in order to allow bone graft material to be placed between the two implants and to provide maximum contact between natural bone and the implants.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernard et al. (FR 2 795 945) in view of Baccelli et al. (2003/0028249).

Bernard et al. disclose the claimed invention except for the device being formed from a plastic such as polyetheretherketone (PEEK). Baccelli et al. disclose an implant 2 formed from PEEK in order to make the device transparent to X-ray waves and facilitate inspection of the implant (see Fig. 1 and par. 0050). It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the implant of Bernard et al. from a plastic such as PEEK, in view of Baccelli, in order to make the device transparent to X-ray waves and facilitate inspection of the implant. It is noted that even in the absence of teachings from references such as Baccelli et al., it would have been obvious to form the implant from PEEK or from any of numerous other known materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.

DC

D. Comstock
01 October 2004

KEVIN SHAVER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700